



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,117	10/24/2003	Alan Draper	30373-11	1649
7663	7590	04/21/2005	EXAMINER	
STETINA BRUNDA GARRED & BRUCKER			KLEBE, GERALD B	
75 ENTERPRISE, SUITE 250			ART UNIT	
ALISO VIEJO, CA 92656			PAPER NUMBER	

3618

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/693,117	Applicant(s) DRAPER ET AL.	
	Examiner Gerald B. Klebe	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17,21 and 22 is/are rejected.
- 7) ☐ Claim(s) 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

G.B. Klebe
4 April 2005

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. The amendment filed 02/10/2005 under 37 CFR § 1.111 has been entered. Claims 1, 3-17 and 21-25 are pending in the application, claims 2, and 18-20 being cancelled and new claims 21-25 being added by the amendment.

Withdrawal of Prior Indication of Allowable Matter

2. The previously indicated allowability of claim 7 is withdrawn in view of the newly discovered reference to Cheng (US 6663125). Rejection of the claim based on the newly cited reference follows, together with an examination on the merits of the other pending claims as amended 02/10/2005.

Claim Objections

3. Claim 8 is objected to because of the following informalities: in line 1, the “f” should be replaced with the word --of--. Appropriate correction is required.

Specification - Objections

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide antecedent basis for the limitations recited in claims 23-25 wherein at lines 6-7 the limitation is recited that “ ... a tube disposed in radially spaced relation to the first elongate member, the tube being welded to the first [examiner’s emphasis] elongate member and having the fastener receiver mounted thereon ... ”. Whereas the

Art Unit: 3618

specification at page 11, paragraph [0033] in line 1 states that "... the fastener receiver 70 is mounted to the female element 55...", in which case it is the second [examiner's emphasis] elongate member (defined as having a female element attached thereto) on which the fastener receiver member is mounted, as shown in Figure 3 of the drawings.

Appropriate correction is required. No new matter should be added.

Claims Rejections - 35 U.S.C. § 112, 2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15-17 fail to recite limitations of steps in a method as required by their dependence upon the independent method claim 14. Therefore, it is unclear whether these claims are intended to relate to the method as recited in claim 14 or whether each is intended, instead, to depend from a claim different from claim 14 reciting the features of a device.

Appropriate correction is required.

For purposes of further examination on the merits the claims will be interpreted by the examiner as if reciting features of steps of a process of "providing" as relates to the method of claim 14.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3618

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3-6, 9, and 22 are rejected under 35 U.S.C. 103(a) as being anticipated by Elrod (US 2003/0178805 A1).

Elrod discloses a vehicle step comprising:

(**re: claim 1**) a first elongate member (12) including a first coupling section and having a male element comprising a tube disposed in radially spaced relation to the first elongate member and being attached to the first elongate member (refer para [0061]; [the **examiner notes that**, by being made integral, the male element is attached to the first elongate member]; and a second elongate member (11) including a second coupling section and having a female element comprising a tube disposed in radially spaced relation to the second elongate member and being attached to the second elongate member (refer para [0061]) ; wherein the male element is insertable within the female element (refer para [0030]);

EXAMINER'S NOTES: An integral structure may be construed as made up of a number of elements which, clearly, are attached to each other but which are distinguished; and, (b) an integral structure such as a tube may be considered as being made up of a number of longitudinally connected elements which are in radially spaced relation whether the radius of the tube surface is changing, for example being tapered, or not changing, for example being cylindrical only.

and,

Art Unit: 3618

(**re: claim 3**) wherein the first and second elongate members are substantially tubular and structured to couple to a vehicle (refer para [0040] and [0046]; and,

(**re: claim 4**) wherein the first elongate member (12) includes a first end and a second end, wherein the first end is structured to couple to a vehicle and the second end includes a male element (refer para [0030] and [0063]; and,

(**re: claim 5**) wherein the second elongate member includes a first end, a second end and a frame coupling member, wherein the first end comprises a female element and the frame coupling member is structured to couple to a vehicle (refer para [0063], [0064], and [0065]); and,

(**re: claim 6**) further comprising an anti-rattle member (refer para [0061] at lines 5-9); and,

(**re: claim 9**) further comprising a step surface located on the first member, or the second member, or on both members (in the case of this reference (as shown), a step surface 14a, 14b is located on each member of the vehicle side step); and,

(**re: claim 22**) wherein the male and female elements each comprises a tube, the male element being of a smaller diameter than that of the female element (refer para [0068]).

9. Claims 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheng (US 6663125).

Cheng discloses a vehicle step comprising (**re: claim 7**) a first elongate member (44) including a first coupling section; a second elongate member (46) including a second coupling section; and a fastener (54) positioned in the second coupling section, the fastener arranged to extend through the second coupling section so that it contacts the first coupling section; and (**re: claim 8**) further comprising a band (70) sized to conceal a portion of the vehicle step; and (**re: claim 9**) further comprising a step surface (64) located on the first member, or the second

Art Unit: 3618

member, or on both members (in the reference to Cheng cited here, the step surface is disclosed as located on the second member).

10. Claims 10, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Weir (US 6726230 B2).

Weir discloses: **(re: claim 10)** a vehicle step comprising a first member (Fig 1B; item 32) having a first end comprising a male element (60) disposed in radially spaced relation to the first member; a second member (34) having a second end comprising a female element (44) disposed in radially spaced relation to the second member; and wherein the first member and the second member are fixedly attached by positioning the male element within the female element; and
(re: claim 12) wherein the first member and the second member are fixedly coupled to a vehicle; and,
(re: claim 13) further comprising a step surface located on the first member, or the second member or on both members (in the Weir reference cited herein both the first member and the second member each comprise a step surface (items 15 and 14, respectively) located thereon, as shown in Fig 1B).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3618

12. Claim 21 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod (US 2003/0178805 A1).

As discussed above, Elrod discloses all of the features of claim 1 from which claim 21 depends.

Regarding the limitations recited in claim 21, the male element of the first elongate member and the female element of the second elongate member of Elrod are each integral with their respective elongate members and serve to disclose the claimed invention except for being integral rather than being attached by welding to their respective tubular elongate members. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used separate pieces of tubes and to have attached each to their respective tubular elongate member by welding, since it has been held that constructing a formerly integral structure in various separate elements involves only routine skill in the art. (*Nerwin v. Erlichman*, 168 USPQ 177, 179), and furthermore, the examiner takes Official Notice that it is old and well-known to join structural tubular elements by welding depending upon the type of material of which the elements are made (and refer to the reference at para [0058]).

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elrod (US 2003/0178805 A1) in view of Weir (US 6726230 B2).

As discussed above, Elrod discloses all of the features of claim 1 from which claim 8 depends.

Elrod lacks explicit disclosure of a band, sized to conceal a portion of the vehicle step.

However, Weir teaches a vehicle side step comprised of two elongate tubular parts fitted together and using a band to cover the mating seam between the two elongate tubular members.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the side step of Elrod to include in accordance with the teachings of Weir, a tubular band covering the seam where the two elongate members are connected in order to help prevent moisture, snow and ice from getting inside the tubular members where its accumulation over time could lead to corrosion weakening the side step structurally.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weir (US 6726230 B2).

As discussed above, Weir discloses all of the features of the invention of claim 10 from which claim 11 depends. **Relative to the features of claim 11**, Weir further discloses that the female element (44) comprises an aperture (taken as the semicircular notch 42) within the second member(34) (as shown in Fig 1B and discussed in the associated text at col 3, lines 27-35) but Weir discloses a male element that is elongate but with the cross-section of a right angle rather than a tube.

However, it has been generally held to be within the skill of a worker in the art to make an element any shape as a matter of obvious engineering choice when the shape is not for any stated reason or any particular purpose.

Therefore, it would have been obvious to one of ordinary skill to make the male element of the reference a tubular shape since the latter shape would be expected to facilitate a stronger structural connection, especially against bending, between the male member and the interior of the first and second members. *In re Dailey*, 357 F.2d 699, 149 USPQ 47 (CCPA 1966).

Claims Rejections - 35 USC § 102 or 103(a)

15. Claims 14, and 15-17 as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Elrod (US 2003/0178805) or, in the alternative, under 103(a) as being obvious over Elrod (2003/0178805).

a. As discussed above, relative to claims 1, 3 and 9, the reference of Elrod discloses the apparatus of a vehicle step in which the method of claim 14, and claims 15-17 as understood, is considered inherent.

The examiner posits that the Elrod reference teaches the claimed method of the claims 14, and 15-17 as understood, because the method is inherently disclosed. The rationale for this inherency is that the prior art device of Elrod in its normal and usual application would necessarily require the claimed method for the assembly and mounting of the disclosed step apparatus on a vehicle. See MPEP Sec. 2112.02, and refer *In re King*, 801 f2d 1324, 1326; 231 USPQ 136, 138 (Fed cir 1986).

b. However, even if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the reference of Elrod to include the claimed method of claims 14, and 15-17 as understood. Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be an obvious step in light of the disclosed structures of the reference of Elrod.

Allowable Subject Matter

16. Claims 23-25 are objected to as being not supported by the specification as originally filed, but would be allowable if rewritten to recite these limitations as disclosed in the specification including the drawings as originally filed.

Response to Arguments

17. Applicant's arguments with respect to the claims rejections based on Straka (-683) have been fully considered but are moot in view of the new ground(s) of rejection.

Applicant's argument with respect to the claims 10-13 have been fully considered but are moot in view of the new ground(s) of rejection.

Applicant's argument with respect to the rejections of claim and its dependencies and claim 14 and its dependencies based on Elrod (US 2003/0178805 A1) have been fully considered but are moot in view of the new ground(s) of rejection. However, it is worth noting here that (a) an integral structure may be construed as made up of a number of distinct elements which, clearly, are attached to each other; and, (b) an integral structure such as a tube may be considered as being made up of a number of longitudinally connected elements which are in radially spaced relation whether the radius of the tube surface is changing, for example tapered, or not changing, for example cylindrical. If the structure being claimed has different radii it is up to the claim recitations to clearly and unambiguously distinguish the structure being claimed from the structure of the prior art.

Art Unit: 3618

Prior Art made of Record

18. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Geyer; and of Holloway et al. each show features in common with some of the other structures of the inventive concept disclosed in the instant application.

Conclusion

19. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at ⁵⁷¹⁻²⁷²⁻⁶⁶⁹⁵~~703-305-0578~~, fax 703-872-9306; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 703-308-2560.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gbklebe
gbklebe / Art Unit 3618 / 4-Apr-05

[Signature] 4/18/05
FRANK VANAMAN
PRIMARY EXAMINER